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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHEN, VICTORIA W

ART UNIT

PAPER NUMBER

3739

NOTIFICATION DATE

DELIVERY MODE

06/14/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
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Office Action Summary	Application No. 10/566,204	Applicant(s) SUGIYAMA ET AL.	
	Examiner VICTORIA W. CHEN	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,7-13 and 20-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-6,14-19,27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 3-6, 14, 15, 27, 28 and 33-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Saadat et al. (US 2004/0138525 A1).

Regarding claim 3, Saadat discloses an internal treatment apparatus for a patient comprising a flexible tubular body [10] to be introduced into a patient, said flexible tubular body comprising: a center opening [24] for inserting therethrough an endoscope for observing a target site, said center opening extending through said flexible tubular body from a center of a distal end face [Figs. 2 and 2B] of said flexible tubular body, said distal end face facing said target site, and a plurality of circumferential apertures [26] through which surgical instruments are inserted for performing a surgical procedure on said target site, said plurality of circumferential apertures being provided to extend through said flexible tubular body from a side face [Fig. 25A, side face where tool arms 32 enter body 10] of said flexible tubular body.

Regarding claim 4, Saadat discloses an internal treatment system for a patient comprising: a flexible tubular body [10] to be introduced into a patient, said flexible tubular body including a center opening [24] for inserting therethrough an endoscope for observing a target site, said center opening being circular in cross section and extending through said flexible

Art Unit: 3739

tubular body from a center of a distal end face of said flexible tubular body [Figs. 2 and 2B], said distal end face facing said target site, and a plurality of circumferential apertures [26] through which surgical instruments are inserted for performing a surgical procedure on said target site, said plurality of circumferential apertures being provided to extend through said flexible tubular body from a side face of said flexible tubular body [Fig. 25A, side face where tool arms 32 enter body 10]; a body manipulating device [22] for manipulating said flexible tubular body from outside said patient; an endoscope manipulating device [proximal end of scope 28] for manipulating said endoscope from outside said patient; and a surgical instrument manipulating device [35] for manipulating said surgical instruments from outside said patient.

Regarding claim 5, Saadat discloses an internal treatment apparatus for a patient comprising a flexible tubular body [10] to be introduced into a patient, said flexible tubular body comprising: a center opening [24] for inserting therethrough an endoscope for observing a target site, said center opening extending through said flexible tubular body from a center of a distal end face of said flexible tubular body [Figs. 2 and 2B], said distal end face facing said target site, and a plurality of circumferential apertures [26] through which surgical instruments are inserted for performing a surgical procedure on said target site, each of said plurality of circumferential apertures being provided to extend through said flexible tubular body in an area including said distal end face [Fig. 6, distal end face where tool arms 30 protrude from 10] and a side face [Fig. 2, side face where tool arms 32 enter body 10] of said flexible tubular body.

Regarding claim 6, Saadat discloses an internal treatment system for a patient comprising: a flexible tubular body [10] to be introduced into a patient, said flexible tubular body including a center opening [24] for inserting therethrough an endoscope for observing a target

Art Unit: 3739

site, said center opening being circular in cross section and extending through said flexible tubular body from a center of a distal end face of said flexible tubular body [Figs. 2 and 2B], said distal end face facing said target site, and a plurality of circumferential apertures [26] through which surgical instruments are inserted for performing a surgical procedure on said target site, each of said plurality of circumferential apertures being provided to extend through said flexible tubular body in an area including said distal end face [Fig. 6, distal end face where tool arms 30 protrude from 10] and a side face [Fig. 25A, side face where tool arms 32 enter body 10] of said flexible tubular body; a body manipulating device [22] for manipulating said flexible tubular body from outside said patient; an endoscope manipulating device [proximal end of scope 28] for manipulating said endoscope from outside said patient; and a surgical instrument manipulating device [35] for manipulating said surgical instruments from outside said patient.

Regarding claims 14 and 27, the circumferential apertures are considered to be positioned at apertures labeled 32 in Fig. 2 and also at the distal end face where the arms 34 protrude from apertures located near 14 in Fig. 2. Between these sets of apertures in Fig. 2 are clearly shown grooves on body 10.

Regarding claims 15 and 28, Saadat discloses a projection angle of said surgical instruments from said flexible tubular body is smaller than a half angle of a field of view of said endoscope [Fig. 6].

Regarding claims 33-36, Saadat discloses the flexible tubular body comprises a resiliently deflectable portion [20], and a circumferential opening portion [Fig. 25A, portion starting from where 20 is labeled, including side face where tool arms 32 enter 10, extended toward where element 22 is labeled] includes said plurality of circumferential apertures [26], and the

Art Unit: 3739

circumferential opening portion passes through the apparatus body from a side face [Fig. 25A, side face where tool arms 32 enter body 10] of the deflectable portion toward a proximal end face [e.g. where 22 is labeled in Fig. 25A] of the apparatus body.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 16-19 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saadat, as applied to claims 3 and 4 above, in view of Lys et al. (US 2003/0100837 A1).

Saadat teaches the invention as claimed, but fails to teach the endoscope comprising an illumination device which emits white light and the surgical instruments each comprising an illuminating device which emits colored light, and the light emitted by the illuminating devices being of different intensity than that emitted by the endoscope. Saadat does teach that the surgical instruments can comprise secondary scopes [par. 0017]. It is considered commonly

Art Unit: 3739

known in the art that endoscopes comprise illumination fibers for illuminating the area being observed [see e.g. US 5569163, col. 1, ll. 1-55; US 5617498, col. 1, ll. 10-24]. Lys teaches an endoscope [2092] having a plurality of light sources [2100, par. 0352] capable of emitting a range of different colors at varying intensities and frequencies [par. 0371] to provide the advantage of allowing the operator to identify, diagnose and better visualize different anatomical structures [par. 0353-0354]. Therefore, it would have been obvious to one of ordinary skill to provide the scopes as taught by Saadat with the light system as taught by Lys to provide the advantage of allowing the operator to identify, diagnose and better visualize different anatomical structures.

Response to Arguments

Applicant's arguments filed 3/18/10 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the claimed language only requires the plurality of circumferential apertures to extend through the flexible tubular body in an area including the distal end face and a side face, without specifically claiming the location of the side face. There is no claim language which precludes the side face of Saadat to read on the invention.

Therefore, the rejections are upheld.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3739

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA W. CHEN whose telephone number is (571)272-3356. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victoria W Chen/
Examiner, Art Unit 3739

/John P Leubecker/
Primary Examiner, AU 3739